

REMARKS

Claims 1-24 are pending in this application. Claim 1 has been amended.

In the Office Action, claims 1-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,867,649 (Kawashima) in view of Japanese Patent No. 61-177327 (Ono). This rejection is respectfully traversed. Applicants hereby request reconsideration and allowance of the claims in view of the following arguments.

Regarding the rejection of independent claim 1, this claim has been amended to specify that a compressor *bearing* component has the claimed grain size. This amendment is fully supported, for example, at page 14, lines 11-16 of the present application. No new matter has been added.

It would not have been obvious to combine Kawashima and Ono to yield the invention of claim 1, because one skilled in the art would not have a reason to do so. Ono teaches treating steel wire rod to have an austenitic grain size of 11 or below, to facilitate drawing the wire and to improve the characteristics of the resulting wire rod. However, Kawashima teaches a compressor. The relevant parts of Kawashima's compressor (i.e., the bearing components, as recited in claim 1) are not made of stainless steel wire rod, and are not taught to be drawn. Therefore, one skilled in the art would not have a reason to use Ono's surface roughening treatment on Kawashima's bearing components. Said another way, there is no teaching or suggestion in the prior art that Ono's austenitic grain wire is useful for making a bearing component, so a skilled artisan would have no reason to modify Kawashima's compressor to incorporate a bearing component having Ono's disclosed austenitic grain size.

Consequently, amended claim 1 is patentable.

Regarding the rejection of independent claims 2, 3, 11, and 18, it is contended in the Office Action that the recited fracture stress value of claims 2 and 11, and the recited hydrogen content of claims 3 and 18 are inherent in the disclosure of Ono. However, there is no support in the Office Action for this contention. Therefore, the Examiner has not met their burden of establishing inherency. It is well-established the Examiner must provide a rationale or evidence tending to show inherency. *See*, MPEP § 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijchaert*, 9 F.3d 1531, 1534 (Fed. Cir, 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F3d 743, 745 (Fed. Cir. 1999). Moreover, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the Office Action, the Examiner’s only support for the conclusion of inherency is “[t]here is reasons to believe, base on the similarity of (structure etc.) that the functional limitation(s) of the fracture value being 2650 MPa and the hydrogen content of 0.5 ppm restricted is (an) inherent characteristics) of (the prior art).” This bald statement is purely speculative, and cannot establish inherency under the legal standards set forth in § 2112 of the MPEP. For example, what “similarity of structure” is the Examiner referring to between the claimed invention and the prior art? How does such a similarity lead to the conclusion that the

cited prior art necessarily has the claimed hydrogen content and fracture stress characteristics?

Where is the statement of facts and scientific principles upon which the Examiner is basing the conclusion of inherency? In other words, this is not a reasonable assertion of inherency by the PTO.

Thus, the Examiner has not made out a *prima facie* case of obviousness. Moreover, since the PTO has not met its burden of establishing a *prima facie* ease of obviousness by stating a reasonable assertion of inherency, the burden of proof of disproving inherency has not shifted to the Applicants.

Consequently, independent claims 2, 3, 11, and 18 are patentable, as are claims 12-17 and 19-24, which depend from claims 11 and 18, respectively.

Regarding the obviousness rejection of independent claim 4, it would not have been obvious to combine Kawashima and Ono to yield the invention of this claim, because one skilled in the art would not have a reason to do so. Ono teaches treating steel wire rod to have an austenitic grain size of 11 or below, to facilitate drawing the wire and to improve the characteristics of the resulting wire rod. However, Kawashima teaches a compressor. The relevant parts of Kawashima's compressor (i.e., the rolling elements and the railway surface of a bearing, as recited in claim 4) are not made of stainless steel wire rod, and are not taught to be drawn. Therefore, one skilled in the art would not have a reason to use Ono's surface roughening treatment on Kawashima's bearing elements. Said another way, there is no teaching or suggestion in the prior art that Ono's austenitic grain wire is useful for making bearing rolling elements or a bearing railway surface, so a skilled artisan would have no reason to modify

Kawashima's compressor to incorporate bearing rolling elements or a railway surface having Ono's disclosed austenitic grain size.

Thus, the combination of Kawashima and Ono does not render independent claim 4 obvious.

Consequently, claim 4 is patentable, as are claims 5-10, which depend from claim 4.

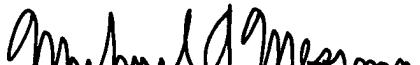
Accordingly, it is believed that the application is now in condition for allowance.

Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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